

REMARKS

1. Summary of the Rejections in the Office Action of February 4, 2005

At page 1, paragraph 4 of the Office Action, the Examiner rejects claims 26-43 under 35 U.S.C. § 103(a), as allegedly being obvious in view of U.S. Patent No. 5,913,215 to Rubenstein et al. (“Rubenstein”) and U.S. Patent No. 6,061,738 to Osaku et al. (“Osaku”). This is the only rejection in the above-captioned patent application.

2. 35 U.S.C. § 103(a) Rejections

At page 1, paragraph 4 of the Office Action, the Examiner rejects claims 26-43 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Rubenstein and Osaku.

The Applicant respectfully TRAVERSES the Examiner’s obviousness rejections and asserts the following remarks in response:

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner’s proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143 (emphasis added). The Applicant maintains that the Examiner fails to establish a prima facie case for obviousness because the Examiner fails to satisfy his burden of showing that the combination of Rubenstein and Osaku discloses or suggests all of the claimed limitations of claims 26-43

a. **Claims 32-35 and 40-43**

The Applicant has canceled claims 32-35 and 40-43, without prejudice to the subject matter claimed thereby. Therefore, the obviousness rejection of claims 32-35 and 40-43 is rendered moot by the foregoing amendments.

b. **Independent Claims 26 and 36**

The Applicant's independent claim 26 recites, in part: "a system for building and executing a network navigation instruction via corresponding sentence construction, comprising . . . a client data processing system coupled to said server data processing system via an electronic data network and configured with at least one program, said at least one program causes said client data processing system to access said server data processing system to load said network content index into a local storage facility, to facilitate construction of a navigation sentence via user selection of a verb from said verb index, thereby selectively designating a portion of said subject index corresponding to said verb and **narrowing a range of searchable subjects contained in said subject index**, selection of a subject from said portion of said subject index, thereby selectively designating a portion of said provider index corresponding to said subject and **narrowing a range of searchable providers contained in said provider index**, and selection of a provider from said portion of said provider index, thereby designating a destination." The Applicant's independent claim 36 recites, in part: "a method for building and executing a navigation instruction comprising the steps of . . . selecting a verb from said verb index, **thereby narrowing a range of searchable subjects contained in said subject index**; [and] . . . selecting a subject from said subject index,

thereby narrowing a range of searchable providers contained in said provider index.”

Thus, in the Applicant’s claimed invention as set forth in independent claims 26 and 36, the selection of a verb from the verb index by a user narrows the range of subjects that the user subsequently may select from the subject index, and likewise, the selection of a subject from the subject index by the user narrows the range of providers that the user subsequently may select from the provider index. As such, the selection of a particular verb by the user affects (limits) the list of subjects available for user selection, and the selection of one of the available subjects by the user affects (limits) the list of providers available for user selection.

In contrast to the Applicant’s claimed invention as set forth in independent claims 26 and 36, Rubenstein states that a computer-user is prompted to “construct a search expression, then [to] communicate the search expression to each of a plurality of search engines located at respective World Wide Web sites. Each of the plurality of search engines is prompted to concurrently identify a respective plurality of web pages containing text consistent with the search expression and to return a respective URL for each such web page identified.” Rubenstein, Abstract. The system of Rubenstein then identifies keyword phrases from these web pages, and automatically generates a list of the keyword phrases. The computer-user then constructs a keyword search expression from the list of the keyword phrases. See, e.g., Id. at Column 2, Lines 27-38. Nevertheless, **the selection of one keyword phrase in Rubenstein does not in anyway affect, e.g., limit, the computer-user’s ability to subsequently select another of the keyword phrases.** Consequently, Rubenstein does not disclose or suggest that the selection of a verb from the verb index by a user narrows the range of subjects that the

user subsequently may select from the subject index, and that the selection of a subject from the subject index by the user narrows the range of providers that the user subsequently may select from the provider index, as set forth in the Applicant's independent claims 26 and 36. Moreover, the Examiner does not assert that Osaku discloses or suggests these missing limitations. Therefore, the Applicant respectfully requests that the Examiner withdraw the obviousness rejections of claims 26 and 36, and allow the same to issue in a U.S. patent.

c. Dependent Claims 27-31 and 37-39

Claims 27-31 and 37-39 depend from independent claims 26 and 36, respectively. "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious." MPEP 2143.03 (citations omitted). Therefore, the Applicant respectfully requests that the Examiner also withdraw the obviousness rejections of claims 27-31 and 37-39, and allow the same to issue in a U.S. patent.

<THIS SPACE IS LEFT BLANK INTENTIONALLY>

CONCLUSION

The Applicant respectfully submits that the above-titled patent application is in condition for allowance, and such action is earnestly requested. If the Examiner believes that an in-person or telephonic interview with the Applicant's representatives will expedite the examination of this application, the Examiner is invited to contact the undersigned attorney of record. The Applicant believes that no fees are due as a result of this submission. However, in the event of any variance between the fees determined the Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

Arent Fox PLLC

By: 

Timothy J. Churna
Registration No. 48,340
FOR: Erik B. Cherdak
Registration No. 39,936

Arent Fox PLLC
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 857-8933
Facsimile No. (202) 857-6395
EBC/TJC:klf

Dated: 2/16/05